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MARSHALL GERSTEIN & BORUN

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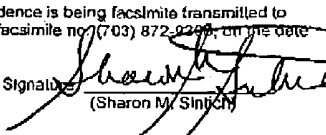
NO. 2999 P. 3/10

JUN 25 2004

OFFICIAL

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Dated: June 25, 2004

Signature: 
(Sharon M. Sinitich)

Docket No.: 29915/6177PCP
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gurney et al.

Application No.: 09/806,194

Group Art Unit: 1647

Filed: September 17, 2001

Examiner: C. Nichols

For: ALZHEIMER'S DISEASE SECRETASE

**INFORMATION DISCLOSURE STATEMENT (IDS) AND SUBMISSION UNDER 37
C.F.R. §1.114 WITH REQUEST FOR CONTINUED EXAMINATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Preliminary Remarks

Submitted herewith is a PTO-Form 1449 listing documents A1-A44, B1-B23 and C1-C22. Copies of the listed documents are not enclosed because they have already been submitted in related patent application serial no. 09/416,901 filed October 13, 1999. Pursuant to 37 C.F.R. §1.98(d), copies of the documents are not submitted herewith. Some of the cited art may be more relevant to the proteases disclosed in the present application rather than the claimed App molecules.

II. Prosecution Strategy

A multi-application filing strategy was initiated to expedite prosecution of the Asp2 patent applications. Petitions to make special require restriction to a single invention. It was predicted that the originally filed claims in 09/416,901 would be restricted into at least 5 claim groups (human Asp2 polynucleotides, human Asp2 polypeptides, methods of screening, murine Asp2 polynucleotide and polypeptide sequences, and methods of using antisense oligonucleotides). Therefore, 10 divisional applications were filed in April, 2000 wherein these 5 claim groups were each presented in two divisional applications. Petitions to make special were filed in five of the divisional applications (one for each claim set).

Because of anecdotal evidence that petitions to make special will sometimes actually slow prosecution, five identical applications were filed without petitions.

The American Inventor's Protection Act of November 29, 2000 created new provisional rights in the United States based on a published application. Therefore, five additional divisional applications were filed in February, 2001 for the purpose of publication in the United States. Since the speed at which the U.S. PTO would publish these applications was uncertain, three PCT applications were filed with the International Bureau with a request for expedited publication in May, 2001. The present application is a national phase application of one of these PCT applications. These steps were taken to have an application publish and be effective in the U.S. for provisional rights as soon as possible.

III. Related Applications

Submitted herewith, as Appendix A, is list of pending and issued U.S. patent applications that are related to the above-identified application. The related applications claim priority to U.S. provisional applications 60/101,594 and 60/155,493, and U.S. application 09/404,133 (abandoned). One or more of the related applications may contain claims that are similar in scope or content to claims of the present application. Copies of these applications are not enclosed, but are pending in the U.S. Patent Office and should be available to the Examiner.

During the course of prosecution of these applications, different examiners have raised a variety of rejections under 35 U.S.C. §102, §103, §112, first and second paragraphs, and double patenting. Upon request, the Applicants will provide the Examiner with copies of office actions and/or responses filed for the related applications. The Examiner is invited to contact the undersigned if further explanation of the patent family is necessary.

IV. Conclusion

This Information Disclosure Statement is submitted with a Request for Continued Examination and therefore before the receipt of an Office Action on the merits. Thus, the applicants believe no fee is due with this statement. See 37 C.F.R. §1.97(b). However, please charge any necessary fees due in connection with this Information Disclosure Statement to Deposit Account No. 13-2855. A copy of this paper is enclosed herewith.

Dated: June 25, 2004

Respectfully submitted,

By 

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Registration No.: 48,484

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Form PTO-1449 (Modified)		U.S. Department of Commerce Patent and Trademark Office		Attorney Docket No. 29915/6177PCP	Serial No. 09/806,194
INFORMATION DISCLOSURE STATEMENT				Applicant Gurney et al.	
				Filing Date September 17, 2001	Group 1647

U.S. PATENT DOCUMENTS							
*Examiner Initials		Document Number	Issue Date	Name	Class	Subclass	Filing Date If Appropriate
	A1	5,424,205	6/13/95	Dovey et al.	435	226	
	A2	5,593,846	1/14/97	Schenk et al.	435	7.9	
	A3	5,733,768	3/31/98	Dixon et al.	435	226	
	A4	5,744,346	4/28/98	Chrysler et al.	435	226	
	A5	5,750,349	5/12/98	Suzuki et al.	435	7.1	
	A6	5,766,846	6/16/98	Schlossmacher et al.	435	6	
	A7	5,837,672	11/17/98	Schenk et al.	514	2	
	A8	5,849,560	12/15/98	Abraham	435	219	
	A9	5,942,400	8/24/99	Anderson et al.	435	7.1	
	A10	6,025,180	2/15/00	Powell et al.	435	219	
	A11	5,455,169	10/3/95	Mullan	435	240.2	
	A12	5,795,963	8/18/98	Mullan	435	350	
	A13	5,877,015	3/2/99	Hardy et al.	435	325	
	A14	6,211,428	4/3/01	Singh et al.	800	13	
	A15	6,221,645	4/24/01	Chrysler et al.	435	226	
	A16	6,245,884	6/12/01	Hook	530	300	
	A17	6,245,964	6/12/01	McLonogue et al.	800	12	
	A18	60/141,363	N/A	Lin et al.			6/28/99
	A19	60/168,060	N/A	Lin et al.			11/30/99
	A20	60/178,368	N/A	Lin et al.			1/27/00
	A21	60/210,292	N/A	Hong et al.			6/8/00
	A22	09/277,229	N/A	Citron et al.			3/26/99
	A23	6,313,268	11/6/01	Hook	530	350	
	A24	60/177,836	N/A	Lin et al.			1/25/00
	A25	60/119,571	N/A	Basi et al.			2/10/99
	A26	60/139,172	N/A	Anderson et al.			6/15/00
	A27	60/114,408	N/A	Basi et al.			12/13/98
	A28	09/404,578	N/A	Chrysler et al.			9/23/99
	A29	09/054,334	N/A	Anderson et al.			4/2/98
	A30	09/730,329	N/A	Anderson et al.			12/4/00
	A31	09/471,669	N/A	Anderson et al.			12/24/99
	A32	09/501,708	N/A	Anderson et al.			12/10/00
	A33	09/723,722	N/A	Anderson et al.			11/28/00
	A34	09/724,566	N/A	Anderson et al.			11/28/00
	A35	09/723,739	N/A	Anderson et al.			11/28/00
	A36	09/724,571	N/A	Anderson et al.			11/28/00
	A37	09/724,568	N/A	Anderson et al.			11/28/00
	A38	09/724,569	N/A	Anderson et al.			11/28/00
	A39	6,319,489	11/20/01	Powell et al.	435	69.1	
	A40	6,162,630	12/19/00	Powell et al.	435	219	

EXAMINER	DATE CONSIDERED
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

Form PTO-1449 (Modified) U.S. Department of Commerce Patent and Trademark Office INFORMATION DISCLOSURE STATEMENT	Attorney Docket No. 29915/6177PCP	Serial No. 09/806,194
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U.S. PATENT DOCUMENTS							
*Examiner Initials		Document Number	Issue Date	Name	Class	Subclass	Filing Date If Appropriate
	A41	6,319,689	11/20/01	Powell et al.	435	69.1	
	A42	6,358,725	03/19/02	Christie et al.	435	212	
	A43	6,361,975	03/26/02	Christie et al.	435	69.1	
	A44	6,545,127	04/08/03	Tang et al.	530	350	

FOREIGN PATENT DOCUMENTS							
*Examiner Initials		Document Number	Publication Date	Country	Class	Subclass	Translation Yes No
	B1	WO 96/31122	10/10/96	PCT			
	B2	WO 96/40885	12/19/96	PCT			
	B3	WO 98/13488	4/2/98	PCT			
	B4	WO 98/21589	5/22/98	PCT			
	B5	EP 0848 062 A2	6/17/98	EPO			
	B6	WO 98/26059	6/18/98	PCT			
	B7	EP 0855 444 A2	7/29/98	EPO			
	B8	WO 99/34004	8/7/99	PCT			
	B9	WO 99/31236	6/24/99	PCT			
	B10	WO 99/46281	9/16/99	PCT			
	B11	WO 99/64587	12/16/99	PCT			
	B12	WO 00/23576	4/27/00	PCT			
	B13	WO 00/47618	08/17/00	PCT			
	B14	WO 00/58479	10/05/00	PCT			
	B15	WO 00/56871	9/28/00	PCT			
	B16	WO 00/68266	11/16/00	PCT			
	B17	WO 00/69262	11/23/00	PCT			
	B18	WO 01/00663	1/4/01	PCT			
	B19	WO 01/00665	1/4/01	PCT			
	B20	WO 01/29563	4/26/01	PCT			
	B21	WO 01/31054	5/3/01	PCT			
	B22	WO 01/36600	5/25/01	PCT			
	B23	WO 01/38487	5/31/01	PCT			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)		
C1	Chyung et al. Novel β -Secretase Cleavage of β -Amyloid Precursor Protein in the Endoplasmic Reticulum/Intermediate Compartment of NT2N Cells, <i>Journal of Cell Biology</i> , 138: 671-680 (1997).	

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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)		
C2	Evin et al., Alzheimer's disease amyloid precursor protein (A β PP): proteolytic processing, secretases and β A4 amyloid production, <i>Amyloid; Int. J. Exp. Clin. Invest.</i> , 1: 263-280 (1997).	
C3	Haass et al., Amyloid β -peptide is Produced by Cultured Cells During Normal Metabolism, <i>Nature</i> , 359: 322-325 (1992).	
C4	Haass et al., β -Amyloid Peptide and 3-kDa Fragment are Derived by Distinct Cellular Mechanisms, <i>Journal of Biochemistry</i> , 268: 3021-3024 (February 15, 1993).	
C5	Haass et al., The Swedish Mutation Causes Early-Onset Alzheimer's Disease by β -Secretase Cleavage Within the Secretory Pathway, <i>Nature Medicine</i> , 12: 1291-1296 (1995).	
C6	Hirosawa et al., Characterization of cDNA Clones Selected by the GeneMark Analysis from Size-Fractionated cDNA Libraries From Human Brain, <i>DNA Res.</i> , 6(5): 329-336 (1999).	
C7	Hussain et al., Identification of a Novel Aspartic Protease (Asp ?) as β -Secretase, <i>Molecular and Cellular Neuroscience</i> , 14: 419-427 (1999).	
C8	Kang et al., The Precursor of Alzheimer's Disease Amyloid A4 Protein Resembles a Cell-Surface Receptor, <i>Nature</i> , 325: 733-736 (1987).	
C9	Kitaguchi et al., Novel Precursor of Alzheimer's Disease Amyloid Protein Shows Protease Inhibitory Activity, <i>Nature</i> , 331: 530-532 (1988).	
C10	Knops et al., Cell-type and Amyloid Precursor Protein-type Specific Inhibition of A β Release by Bafilomycin A1, a Selective Inhibitor of Vacuolar ATPases, <i>Journal of Biological Chemistry</i> , 270: 2419-2422 (1995).	
C11	Koo and Squazzo, Evidence that Production and Release of Amyloid β -Protein Involves the Endocytic Pathway, <i>Journal of Biological Chemistry</i> , 269: 17386-17389 (1994).	
C12	Ponte et al., A New A4 Amyloid mRNA Contains a Domain Homologous to Serine Proteinase Inhibitors, <i>Nature</i> , 331: 525-527 (1988).	
C13	Seubert et al., Secretion of β -amyloid Precursor Protein Cleaved at the Amino Terminus of the β -amyloid Peptide, <i>Nature</i> , 361: 260-263 (1993).	
C14	Sinha et al., Purification and Cloning of Amyloid Precursor Protein β -Secretase from Human Brain, <i>Nature</i> , 402: 537-540 (1999).	
C15	Szelesi, The Aspartic Proteases, <i>Scand. J. Clin. Lab. Invest.</i> , 52 (suppl. 210): 5-22 (1992).	
C16	Tanzi et al., Protease Inhibitor Domain Encoded by an Amyloid Protein Precursor mRNA Associated with Alzheimer's Disease, <i>Nature</i> , 331: 528-530 (1988).	
C17	Vasser et al., β -secretase Cleavage of Alzheimer's Amyloid Precursor Protein by the Transmembrane Aspartic Protease BACE, <i>Science</i> , 286 (5440): 735-41 (1999).	
C18	Yan et al., Membrane-anchored Aspartyl Protease with Alzheimer's Disease β -Secretase Activity, <i>Nature</i> , 402: 533-537 (1999).	
C19	Zhao et al., β -Secretase Processing of the β -Amyloid Precursor Protein in Transgenic Mice Is Efficient in Neurons but Inefficient in Astrocytes, <i>Journal of Biological Chemistry</i> , 271: 31407-31411 (1996).	
C20	PCT Search report for PCT/US 99/20881	
C21	Mullan et al., A Pathogenic Mutation for Probable Alzheimer's Disease in the APP Gene at the N-Terminus of β -Amyloid, <i>Nature Genetics</i> 1: 345-347 (1992).	
C22	Elan and Pharmacia form Alzheimer's disease research collaboration in the area of Beta-Secretase, News 08/09/2000, www.elancorp.com.	

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